THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte WILLIAM Y. HALL
and WILLIAM A. HALL

_____

Appeal No. 1998-1426
Application 08/315,350

_____

ON BRIEF

_____

Before ABRAMS, FRANKFORT and GONZALES, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 5, 10, 12, 13, 17, 18, 20 and 30, and from the examiner’s refusal to allow claims 33 through 35 which are subject to new grounds of rejection in the

examiner's answer. Claims 6 through 9, 11, 14 through 16, 19, 21 through 29, 31 and 32, which are all of the remaining claims pending in this application, stand allowed.

We REVERSE and REMAND.

BACKGROUND

The appellants' invention relates to a container for above ground storage of hazardous liquids. An understanding of the invention can be derived from a reading of exemplary claims 1, 12, 17 and 33 which appear in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bliss et al. (Bliss)	2,777,295	Jan. 15, 1957
Durkop	3,848,765	Nov. 19, 1974
Lindquist et al. (Lindquist)	4,826,644	May 2, 1989
De Benedittis et al. (De Benedittis)	4,895,272	Jan. 23, 1990
Sharp	4,912,966	Apr. 3, 1990
Gelin	4,974,739	Dec. 4, 1990
Reese	5,564,588	Oct. 15, 1996 (filed Aug. 21,

1991)

Claims 1, 2, 10, 12, 13, 17, 18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Durkop in view of Bliss.

Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Durkop in view of Bliss and Lindquist.

Claims 4 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Durkop in view of Bliss and Gelin.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Durkop in view of Bliss and De Benedittis.

Claims 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Durkop in view of Bliss and Reese.

Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Durkop in view of Bliss, Reese and Sharp.[1]

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 18, mailed September 18, 1997) and the supplemental examiner's answer (Paper No. 22, mailed August 6, 1999) for the examiner's complete reasoning in support of the rejections, and to the appellants' brief (Paper No. 17, filed

[1]The rejections of claims 33, 34 and 35 under 35 U.S.C. § 103(a) are new grounds of rejection. These rejections were entered by the examiner in his answer (Paper No. 18, mailed September 18, 1997).

May 22, 1997), reply brief

(Paper No. 19, filed November 10, 1997) and supplemental reply brief (Paper No. 23, filed September 17, 1999) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. As a consequence of our review, we make the determinations which follow.

Regarding the examiner’s rejection of independent claims 1, 12 and 17 under 35 U.S.C. § 103(a) as being unpatentable over Durkop in view of Bliss, we refer to appellants' arguments (brief, pages 8-11; reply brief, pages 2-4; and supplemental reply brief, pages 2-7), and note our agreement with appellants' view that the above ground cryogenic storage tank of Bliss and the below ground fuel storage tank of Durkop are entirely different in design, purpose and operation from each other, and that both are far removed from appellants' field of endeavor involving an above ground hazardous material storage tank. Moreover, even if one skilled in the art would

have viewed Bliss and Durkop as being reasonably pertinent to the problem confronted by appellants (a point which we find to be highly questionable), we must agree with appellants that there is no teaching, suggestion or incentive in the applied references which would have led one of ordinary skill in the art to combine the teachings of Bliss with those of Durkop in the manner urged by the examiner. Unlike the examiner (answer, page 5), we do not consider that "[i]t would have been obvious to one of ordinary skill in the art to have employed the insulation teaching of Bliss, et. al. between the inner and outer tanks of the device of Durkop[.]" In this regard, we direct particular attention to appellants' arguments found on pages 2 through 7 of the supplemental reply brief (Paper No. 23) and incorporate the same herein as expressing our own view of the examiner's attempted combination of Durkop and Bliss.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed

invention, absent some teaching or suggestion supporting the combination." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). And "teachings of references can be combined only if there is some suggestion or incentive to do so." Id. Here, the prior art contains none. In fact, the advantages of utilizing an above ground hazardous liquid container are not appreciated by the prior art applied by the examiner.

Instead, it appears to us that the examiner relied on hindsight in reaching his obviousness determination. However, our reviewing court has said, "To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." W. L. Gore & Assoc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). It is essential that "the decision maker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made . . . to occupy the mind of

one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art." Id.

Since we have determined that the examiner's conclusion of obviousness is based on a hindsight reconstruction using appellants' own disclosure as a blueprint to arrive at the claimed subject matter, it follows that we will not sustain the examiner's rejection of independent claims 1, 12 and 17, or of claims 2, 10, 13, 18 and 20, dependent thereon, under 35 U.S.C.
§ 103(a) as being unpatentable over Durkop in view of Bliss.

We have additionally reviewed the patents to Lindquist, Gelin and De Benedittis applied by the examiner against dependent claims 3, 4, 5 and 30, however, we find nothing in these references which provides for that which we have indicated above to be lacking in the basic combination of Durkop and Bliss.
Accordingly, the examiner's rejections of dependent claims 3, 4, 5 and 30 under 35 U.S.C. § 103(a) will likewise not be sustained.

We next turn to the examiner's rejection of independent

claim 33 under 35 U.S.C. § 103(a) as being unpatentable over Durkop in view of Bliss and further in view of Reese. While the patent to Reese is directed to a storage tank system for above ground storage of flammable liquids, we find nothing therein which would overcome or supply that which we have indicated above to be lacking in the basic combination of Durkop and Bliss. We agree with appellants that "the rejection provides no teaching or suggestion as to why it would be [sic, have been] obvious to combine the teaching of an above-ground tank as provided by Reese with the teaching of an underground tank as taught by Durkop or with the teaching of a cryogenic tank having a 'building' type construction as taught by Bliss" (reply brief, page 4). As before, it is our view that the teachings of the prior art relied upon by the examiner (i.e., Durkop, Bliss and Reese) as suggesting the subject matter of independent claim 33 are only sufficient when modified or combined with impermissible hindsight.

Thus, we will not sustain the examiner's rejection of independent claim 33, and claim 34 dependent thereon, under 35 U.S.C. § 103(a) as being unpatentable over Durkop in view of Bliss and Reese.

We have also reviewed the teachings of Sharp relied upon by the examiner along with Durkop, Bliss and Reese in the rejection of claim 35 under 35 U.S.C. § 103(a). However, it is our conclusion that the teachings of Sharp do nothing to provide for that which we have indicated above to be lacking in the basic combination of Durkop, Bliss and Reese. Accordingly, the examiner's rejection of dependent claim 35 under 35 U.S.C.
§ 103(a) will not be sustained.

REMAND TO THE EXAMINER

This application is remanded to the examiner for consideration of a new ground of rejection.

While we have not sustained the examiner's rejection of independent claim 33 under 35 U.S.C. § 103(a) as being unpatentable over Durkop in view of Bliss and Reese, for the reasons stated above, it appears to us that the cited patent to Reese shows each and every feature of appellants' claim 33, and that a rejection of appealed claim 33 under 35 U.S.C. § 102 as being fully anticipated by Reese should be considered during any further prosecution of this application before the examiner.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 through 5, 10, 12, 13, 17, 18, 20, 30 and 33 through 35 under 35 U.S.C. § 103(a) is reversed. In addition, we remand this application to the examiner to consider a new ground of rejection of appealed claim 33.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED and REMANDED

NEAL E. ABRAMS Administrative Patent Judge	)
CHARLES E. FRANKFORT Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JOHN F. GONZALES Administrative Patent Judge	)

CEF/RG:hh

LAW OFFICES OF GREGORY L. ROTH
6 CENTERPOINTE DRIVE, SUITE 780
LA PALMA, CA 90623